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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/098,634	03/13/2002	Geoff S. Chalmers	18360/236825	3718

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ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000

EXAMINER

ZURITA, JAMES H

ART UNIT PAPER NUMBER

3625

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/098,634

Applicant(s)

CHALMERS ET AL.

Examiner

James H. Zurita

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01-July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 11 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 2-10, 13-64 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 June 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election of Invention I.j (claims 1, 11 and 12) in the reply filed on 1 July 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Priority

Acknowledgment is made of applicant's claim for priority to provisional application 60/275861, filed 14 March 2001.

Drawings

The following comments apply to the set of drawings filed on 17 June 2002 and published on 17 October 2002 as PG-PUB 2002/0152093.

The drawings are objected to because of the following errors. Applicant is requested to review his application for similar errors.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the **package tracking number 375** must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Item **380**, mentioned in paragraph 63, does not appear in the figures.

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Item **430** is described as package weight in paragraph 66. Fig. 6, however, shows an arrow pointing to text that reads "1 of 1". Fig. 8A correctly shows item 430 as having a shipment weight of 4.0 lbs.

Item **550**, electronic return notification is missing from the figures.

Items in the **600** series are mentioned in the description of Fig. 9 but do not appear in any figure.

Item **735**, Fig. 10, should be changed to **835**.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action.

The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities:

In paragraph 57, reference to Fig. 3B should be changed to Fig. 4B.

In paragraph 63, online return application **115** should be changed to online return application **150**.

In paragraph 73, merchant application **115** should be changed to merchant **return** application **115**, and label generation application 150 should be changed to label generation application 160.

In paragraph 77, human-readable area 560 should be changed to human-readable area 555.

The description of Fig. 9 mentions several items that are not found in the drawings. See, for example, Item 600, 630, 625, 650.

The description of Fig. 10 mentions several items that are not found in the drawings. See, for example, Item 600, 630, 625, 650.

The description of Fig. 11 omits steps 930, 940, 950.

Applicant is encouraged to review the application for similar errors.

Appropriate correction is required.

Claim Objections

The following claims are objected to because of informalities:

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Claim 1 refers to "...package tracking number..." The term will be given its broadest reasonable interpretation to include any number, code or identifier that may be used to facilitate shipment of merchandise.

In claim1, the term "...associated..." is indefinite. The term will be given its broadest reasonable interpretation to include physical locations linked in any way with the party.

Claim 11 refers to a link. Applicant's disclosures refer to various types of links. The term link will be given its broadest reasonable interpretation as a reference to another document, as in an email attachment.

Appropriate correction is required.

35 USC 101 Rejection

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1 and claims dependent thereupon are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law

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of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Moreover, the courts have found that a claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer. See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). Finally, the Board of Patent Appeals and Interferences (BPAI) has recently affirmed a §101 rejection finding the claimed invention to be non-statutory based on a lack of technology. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble.

In the present case, the preamble discloses "...electronically providing..." However, there is no further mention of technology.

Despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, the courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998). Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Thus, in order for a claimed invention to be statutory, the claimed invention must produce a useful, concrete and tangible result.

["Usefulness" may be evidenced by, but not limited to, a specific utility of the claimed invention. "Concreteness" may be evidenced by, but not limited to, repeatability and/or implementation without undue experimentation. "Tangibility" may be evidenced by, but not limited to, a real or actual effect.]

In the present case, the body of the claims refers to an electronic image, but the functions can be performed without the use of technology.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before

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the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Hauser et al. (US 6,536,659).

As per claim 1, Hauser discloses method(s) of electronically providing a shipping label to a customer that wishes to return a good that was previously purchased from a merchant, said method comprising the steps of:

- (a) initiating a return transaction upon receipt of a return service request (Fig. 1, item 12, Col. 3, lines 43-63); wherein said return service request contains shipping information, said shipping information comprising an address associated with said customer (Col. 3, line 65-Col. 4, line 15) and an address associated with a consignee (Fig. 1, items 20-24, merchandise arrives at a destination associated with a merchant's returns, for example).
- (b) assigning a package tracking number to said return transaction. Col. 3, line 65-Col. 4, line 15. See also references Return Merchandise Authorization number, as in Col.3, lines 43-64.
- (c) generating said shipping label based at least in part on said shipping information and said package tracking number. Col. 3, lines 43-64. see also item 71, bar code tag for tracking disposition of the package.
- (d) providing said shipping label to said customer in electronic form. Col. 4, lines 16-35, Col. 8, lines 45-54, email attachment.

As per claim 11, Hauser discloses (a) storing an electronic image of said shipping label, Fig. 1, item 18; and (b) sending to said customer a link

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associated with said stored electronic image, Col. 8, lines 45-54, the email has a link to an attached document.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hauser in view of Caminiti, Alan, Lyons, Cheryl, United Parcel Service Introduces Advanced Label Imaging System, published by Business Wire on 29 November 1989, sec. 1, page 1, downloaded from the Internet on 19 September 2005.

As per claim 12, Hauser does not specifically disclose that the electronic image of a shipping label is stored on a carrier server. This feature is disclosed by Caminiti, which stores images of shipping labels on the server of a carrier like UPS. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Hauser and Caminiti to disclose that an electronic image of a shipping label is stored on a carrier server.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine Hauser and Caminiti to disclose that an electronic image of a shipping label is stored on a carrier server for the obvious reason that customer service representatives and shippers using a carrier's

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network may be better equipped to respond quickly and accurately to package inquiries.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Zurita whose telephone number is 571-272-6766. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James Zurita
Patent Examiner
Art Unit 3625
19 September 2005

James Zurita
Patent Examiner
Art 3625